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08/30/2004

Edward Grau

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EXAMINER

POLLOCK, GREGORY A

ART UNIT

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3695

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DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/711,172	GRAU, EDWARD	
	Examiner	Art Unit	
	GREG POLLOCK	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 70-73, 82, 85, 89-93 and 109-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 70-73, 82, 85, 89-93 and 109-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the claims filed 08/30/2004.
2. Claims 1-22, 70-73, 82, 85, 89-93, and 109-112 have been examined.

Information Disclosure Statement

3. The information disclosure statement filed 10/02/2008 has been received, considered as indicated, and placed on record in the file.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- a. It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
- b. It does not identify the foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Specification

5. The specification is objected to because the **Brief Summary of the Invention:** and the **Brief Description of the Several Views of the Drawing(s)** sections are missing from the specification:

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

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- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) **Brief Summary of the Invention**: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) **Brief Description of the Several Views of the Drawing(s)**: See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) **Detailed Description of the Invention**: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) **Claim or Claims**: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

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- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Appropriate correction is required.

Claim Objections

- 6. The claims are objected to because of the following minor informalities:
 - a. Claims 1 and 82 are objected to for not complying with the proper form of claims. Each claim begins with a capital letter and ends with a period. MPEP § 608.01(m). Claims 1 and 82 contain multiple capitalizations. Each instance should all be lower case, except for the beginning of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 1-22, 70-73, 82, 85, 89-93, and 109-112 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In independent claims 1 and 82. It is unclear how the individuals "investment preference information" is obtained. Paragraph 53 states that all embodiments include the ability for an individual to enter and change account information and preference information. However, there is no disclosed system for the individual to enter and change account information and investment preference information. Further, there is no description of the physical system upon which the invention operates and interconnects. For example, in Figure 3A, it is unclear what form of storage the "Transaction Data Store" and "Information of Individual" are stored on, or what the Computing System physically runs on. Therefore, the claimed invention is inoperable as disclosed.
9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Regarding claims 71 and 73 reads "**a third party accumulating points based on said completed debit, credit, or stored value card transaction information that can be converted using a predetermined conversion formula**". The use of "can" renders the claim(s) indefinite because it is unclear

whether the limitation(s) following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

11. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the “Information of the Individual” and a means to enter the information. In order for the individual to enter and change account information and preference information, there must be an interface and system connected to the “Information of the Individual”.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-22, 70-73, and 109-112 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. The claims do not recite the use of another statutory class or physical transformation. The claims recite steps involving automatically transferring funds, but do not recite the use of another

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class of statutory subject matter (machine, manufacture, or composition of matter) or a transformation of underlying subject matter.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

15. Claims 1-4, 10, 11, 19-22, 82, 85, 90, 92, 93, and 109-112 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie (U.S. Patent No. 6631358).

As per claim 1, Ogilvie teaches a method **of automatically transferring funds of an individual from a savings or a credit account to a pre-determined investment account of the individual** ([Abstract] and examples [column 4, line 1 – column 5, line 11]), **the method comprising of: Setting up a system for saving information of the individual including a plurality of: savings account information; credit account information; investment account information; debit, credit, or stored value card information** ([column 5, lines 13-45]); **and investment preference information** (legal incremental savings agreement define the mapping of cash transfers to investments [column 9, lines 1 – column 10, line 54]); **Setting up a system for automatically receiving and saving a completed debit, credit, or stored value card transaction information made by an individual** (transfers of balances are performed based on the without any intervening consumer computing activity based on a previously defined mapping to financial institutions [Figures 1-3] and [column 5, line 47 – column 8, line 67, especially column 6, lines 41-43]); **Calculating a fund transfer amount based on the investment preference information and**

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any information of the completed debit, credit, or stored value card transaction ([column 11, lines 43-48]).

As per claim 2, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **additionally comprising the step of withdrawing the fund transfer amount from an account specified in the account information by an electronic funds transfer** ([column 2, lines 43-62, especially line 62]).

As per claim 3, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **additionally comprising the step of temporarily accumulating the fund transfer amount in a demand account until a predetermined completion time** (periodic approach [column 8, lines 33-50] and [column 9, lines 42-52] and [claim 16]).

As per claim 4, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **additionally comprising the step of temporarily accumulating the fund transfer amount in a demand account until a predetermined accumulation amount** (threshold approach [column 8, lines 33-50] and [column 9, lines 42-52]).

As per claim 10, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **additionally comprising the step of withdrawing the fund transfer amount from an account specified in the account information as a debit, credit, or smart card transaction** ([column 2, lines 43-62]).

As per claim 11, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **additionally comprising the step of withdrawing the fund transfer amount from a debit, credit, or smart card used in the original completed transaction** ([column 2, lines 43-62] and [column 4, lines 1-10]).

As per claim 19, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **wherein the fund transfer amount is a percentage of an aggregated sale amount of the completed debit, credit, or stored value card transactions** (percentage of merchandise cost [column 11, lines 43-48] competed within the periodic approach [column 8, lines 33-50] and [column 9, lines 42-52]).

As per claim 20, the rejection of claim 1 has been addressed.
Ogilvie teaches a method **wherein the fund transfer amount is a percentage of a sale amount of the individual completed debit, credit, or stored value card transactions** (percentage of merchandise cost [column 11, lines 43-48]).

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As per claim 21, the rejection of claim 1 has been addressed.

Ogilvie teaches a method **wherein the fund transfer amount is a pre-specified fixed dollar amount for each occurrence of the completed debit, credit, or stored value card transaction** (flat amount per transaction [column 11, lines 43-48]).

As per claim 22, the rejection of claim 1 has been addressed.

Ogilvie teaches a method **wherein the fund transfer amount is based on a calculation of a pre-specified fixed dollar amount and total number of occurrences of the completed debit, credit, or stored value card transactions** (flat amount per transaction [column 11, lines 43-48] competed within the periodic approach [column 8, lines 33-50] and [column 9, lines 42-52]).

As per claim 82, Ogilvie teaches an **article of manufacture for a computer usable program code and computing means** (signals [column 12, line 56 – column 13, line 50] and configured storage media [column 13, lines 51 – column 14, line 28] and [claim 22]).

All of the remaining limits of Claim 82 have been previously addressed in Claim 1, and is therefore rejected using the same prior art and rationale.

As per claim 85, the rejection of claim 82 has been addressed.

All of the remaining limits of Claim 85 have been previously addressed in Claim 2, and is therefore rejected using the same prior art and rationale.

As per claim 90, the rejection of claim 82 has been addressed.

Ogilvie teaches an article of manufacture **additionally comprising of an ability to store data for: a plurality of completed debit, credit, or stored value card transaction information; a plurality of individual account information and investment preference information; a log of completed fund transfer activity; a log of fund transfer information; a balance of monies in a temporary demand account; a log of fees charged; and a history of account activity** (data is transmitted and stored [column 12, line 56 –column 14, line 8], where the types of data transmitted and stored is treated as non-functional descriptive matter.).

As per claim 92, the rejection of claim 82 has been addressed.

An article of manufacture as set forth in claim 82 wherein the computer usable program code for automatically receiving and accumulating a completed debit, credit, or stored value card transaction information made by an individual additionally comprises of receiving and accumulating a plurality of completed debit, credit, or stored value card transaction information (mapping feature [column 8, lines 1-32], [column 11, lines 5-63] and [Figure 3]).

As per claim 93, the rejection of claim 82 has been addressed. Ogilvie teaches an article of manufacture **wherein the computer usable program code for calculating a fund transfer amount from the deposit account to the savings account based on the investment preference information and the completed debit, credit, or stored value card transaction information additionally comprises of calculating a fund transfer amount from the deposit account to the savings account based on the investment preference information and an aggregate of a plurality of completed debit, credit, or stored value card transaction information** (mapping feature [column 8, lines 1-32], [column 11, lines 5-63] and [Figure 3]).

As per claim 109, the rejection of claim 1 has been addressed. Ogilvie teaches a method **wherein said completed debit, credit, or stored value card transaction information includes a transaction made at an Automated Teller Machine (ATM)** ([column 2, lines 46-62] and [column 6, lines 38-41]).

As per claim 110, the rejection of claim 1 has been addressed. Ogilvie teaches a method **wherein said completed debit, credit, or stored value card transaction information includes a transaction made on the internet** ([column 2, lines 46-62] and [column 6, lines 38-41]).

As per claim 111, the rejection of claim 1 has been addressed. Ogilvie teaches a method **wherein said completed debit, credit, or stored value card transaction information includes a transaction made over a telephone** ([column 2, lines 46-62] and [column 6, lines 38-41]).

As per claim 112, the rejection of claim 1 has been addressed. Ogilvie teaches a method **wherein said pending transaction information includes a transaction made at a stored value card reader** ([column 2, lines 46-62] and [column 6, lines 38-41]).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

17. Claims 5-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie (U.S. Patent No. 6631358) in view of Claridge et. al. (PGPub Document No. 20030149629).

As per claim 5, the rejection of claim 1 has been addressed. Ogilvie does not specifically teach a method **further comprising the steps of: comparing the fund transfer amount to a predetermined transfer limit; and canceling a fund transfer if completion of said fund transfer will cause a total balance in the investment account to exceed a predetermined investment account limit.**

Claridge et. al. teaches a method **further comprising the steps of: comparing the fund transfer amount to a predetermined transfer limit; and canceling a fund transfer if completion of said fund transfer will cause a total balance in the investment account to exceed a predetermined investment account limit** ([claim 5]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 6, the rejection of claim 1 has been addressed. Ogilvie does not specifically teach a method **further comprising the steps of: Determining an available space in the investment account by comparing an investment account total to a predetermined investment account limit; and determining if the fund transfer amount is in excess of said available space.**

Claridge et. al. teaches a method **further comprising the steps of: Determining an available space in the investment account by comparing an investment account total to a predetermined investment account limit; and determining if the fund transfer amount is in excess of said available space** ([claim 5]).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 7, the rejection of claim 6 has been addressed.

Ogilvie does not specifically teach a method **additionally comprising the step wherein the fund transfer amount is reduced to an amount that will not result in the investment account exceeding the investment account limit after a fund transfer is complete.**

Claridge et. al. teaches a method **additionally comprising the step wherein the fund transfer amount is reduced to an amount that will not result in the investment account exceeding the investment account limit after a fund transfer is complete ([¶36]).**

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 8, the rejection of claim 7 has been addressed.

Ogilvie does not specifically teach a method **additionally comprising the step wherein said reduction in the fund transfer amount is transferred to a secondary investment account.**

Claridge et. al. teaches a method **additionally comprising the step wherein said reduction in the fund transfer amount is transferred to a secondary investment account ([¶36] and [claims 6 and 7]).**

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 9, the rejection of claim 1 has been addressed.

Ogilvie does not specifically teach a method **wherein the investment preference information includes an investment total and a predetermined investment limit.**

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Claridge et. al. teaches a method **wherein the investment preference information includes an investment total and a predetermined investment limit** ([claim 8]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 12, the rejection of claim 11 has been addressed.

Ogilvie does not specifically teach a method **additionally comprising: receiving a request from the individual to make an investment in a first investment account, wherein the first investment account is designated by the individual as a primary investment account; determining whether making the investment in the first investment account violates at least one predetermined rule relating to the first investment account; and automatically contributing at least a portion of the investment into a second investment account designated by the individual as a secondary investment account, if making the investment in the first investment account violates said at least one predetermined rule.**

Claridge et. al. teaches a method **additionally comprising: receiving a request from the individual to make an investment in a first investment account, wherein the first investment account is designated by the individual as a primary investment account; determining whether making the investment in the first investment account violates at least one predetermined rule relating to the first investment account; and automatically contributing at least a portion of the investment into a second investment account designated by the individual as a secondary investment account, if making the investment in the first investment account violates said at least one predetermined rule** ([¶14], [¶36], and [claims 6 and 7]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 13, the rejection of claim 12 has been addressed.

Ogilvie does not specifically teach a method **further comprising: accessing information received from the individual for designating the first investment account as primary and the second investment account as secondary.**

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Claridge et. al. teaches a method **further comprising: accessing information received from the individual for designating the first investment account as primary and the second investment account as secondary** ([¶13-14], [¶36], and [claims 6 and 7]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 14, the rejection of claim 13 has been addressed. Ogilvie teaches a method **wherein the first investment account is managed by a first investment provider and the second investment account is managed by a second investment provider** ([column 9, lines 53-55]).

As per claim 15, the rejection of claim 12 has been addressed. Ogilvie teaches a method **wherein the predetermined rule is a maximum investment account value** (maximum savings deposits in a given time period [column 8, lines 33-50] and [column 9, lines 42-52] and [column 11, lines 23-33]).

As per claim 16, the rejection of claim 12 has been addressed. Ogilvie teaches a method **wherein the predetermined rule is a maximum contribution amount** (maximum savings deposits [column 8, lines 33-50] and [column 9, lines 42-52] and [column 11, lines 23-33]).

As per claim 17, the rejection of claim 12 has been addressed. Ogilvie does not specifically teach a method **wherein the predetermined rule is violated if making the investment in the first investment account fails**.

Claridge et. al. teaches a method **wherein the predetermined rule is violated if making the investment in the first investment account fails** ([¶13-14], [¶36], and [claims 5- 7]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

As per claim 18, the rejection of claim 17 has been addressed. Ogilvie does not specifically teach a method **further comprising: contributing at least a portion of the investment into the first investment account, if**

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making the investment in the first investment account does not violate at least one predetermined rule.

Claridge et. al. teaches a method **further comprising: contributing at least a portion of the investment into the first investment account, if making the investment in the first investment account does not violate at least one predetermined rule** ([¶33-36] and [claims 5-7]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Claridge et. al. with the invention of Ogilvie to obtain the claimed invention. The motivation would be to allow the invention of Ogilvie to include IRA's and the like, which have yearly contribution ceilings, thus increasing customer participation of the invention.

18. Claims 89 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie (U.S. Patent No. 6631358) in view of Abe et. al. (PGPub Document No. 20030110115).

As per claim 89, the rejection of claim 82 has been addressed. Ogilvie does not specifically teach an article of manufacture **wherein the computer usable program code for allowing an individual to enter account information and investment preference information is responsive to entries for changes in said information.**

Abe et. al. teaches an article of manufacture **wherein the computer usable program code for allowing an individual to enter account information and investment preference information is responsive to entries for changes in said information** (the change management service unit [Figure 1, element 5] receives changes from the user and stores them in a database [¶75, especially lines 6-9] and [Figures 2]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Abe et. al. with that of Ogilvie to achieve the claimed invention. The motivation would be to more effectively utilize or manage changes to user preferences until they are actually paid back to the customers. As a result, the benefits of the purchasers can be improved and their purchasing desires can be increased. In addition, it is possible to activate trading or purchase dealings, thus contributing greatly to industrial developments.

As per claim 91, the rejection of claim 82 has been addressed. Ogilvie teaches the use of fees ([column 10, lines 10-16]).

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Abe et. al. teaches an article of manufacture **wherein the computer usable program code for allowing an individual to enter account information and investment preference information is further adapted to allow the individual to view: a balance of total monies in a temporary demand account; a history of completed fund transfer activity; a listing of fees charged; and a history of account activity** ([¶81-82] and [Figures 12-14]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Abe et. al. with that of Ogilvie to achieve the claimed invention. The motivation would be to more effectively utilize or manage changes to user preferences until they are actually paid back to the customers. As a result, the benefits of the purchasers can be improved and their purchasing desires can be increased. In addition, it is possible to activate trading or purchase dealings, thus contributing greatly to industrial developments.

19. Claims 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie (U.S. Patent No. 6631358) in view of official notice.

As per claims 70-73, the rejection of claim 1 has been addressed.

The invention of Ogilvie does not use third party contributions (either as points or money) computed at predetermined completion time or a predetermined completion amount.

Use of third party contributions (either as points or money) computed at predetermined completion time or a predetermined completion amount is old and well known in the art (for example Discover card and Principal Bank VISA card as cited in Ogilvie [column 1, line 24 – column 2, line 43])

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used third party contributions (either as points or money) computed at predetermined completion time or a predetermined completion amount within the invention of Ogilvie to obtain the claimed invention. The motivation would be to further encourage users to use the invention by giving them money or point incentives.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pollock whose telephone number is 571

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270-1465. The examiner can normally be reached on 7:30 AM - 4 PM, Mon-Fri Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached on 571 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Gregory Pollock/
Examiner, Art Unit 3693

Gregory A. Pollock

/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693